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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,158	01/26/2001	Larry A. Copp	10002193-1	8066

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EXAMINER

LEE, PHILIP C

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 05/21/2004

2

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,158

Applicant(s)

COPP ET AL.

Examiner

Philip C Lee

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-20 are presented for examination.
2. It is noted that although the present application does contain line numbers in the specification and claims, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.
3. The specification is objected to because of the following informalities and grammar errors, page 4, lines 11 and 12, "peripheral 140" [i.e. no peripheral 140 in figures]. Appropriate correction is required.

Claim Rejections – 35 USC 112

4. Claims 5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. Claim language in the following claims is not clearly understood:

- i. As per claim 5, it is unclear what is meant by PML [i.e. please expand on abbreviation].
- ii. As per claim 7, it is uncertain what is meant by UI_SELECT_OPTION.

Claim Rejections – 35 USC 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-4, 6, 9, 11, 14-16 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Manglapus et al, U.S. Patent 6,219,151 (hereinafter Manglapus).

8. As per claims 1, 14 and 16, Manglapus taught the invention as claimed for informing a client of a peripheral address, by way of a peripheral server, the method comprising:

receiving a first message at the peripheral server, wherein the first message contains an address of the client (col. 3, lines 57-62; col. 4, lines 50-52; col. 9, lines 26-34);

generating a second message containing the peripheral address (col. 4, lines 56-63; col. 9, lines 35-42); and

sending the second message to the client address (col. 4, lines 56-63; col. 9, lines 42-46).

9. As per claims 2, 15 and 18, Manglapus taught the invention as claimed in claims 1, 14 and 16 above. Manglapus further taught wherein the peripheral is a printer, and the peripheral server is a print server comprising a print queue (col. 1, lines 25-31; col. 4, lines 42-46).

10. As per claim 3, Manglapus taught the invention as claimed in claim 1 above. Manglapus further taught wherein the first message is a print job (col. 1, lines 25-31).

11. As per claim 4, Manglapus taught the invention as claimed in claim 3 above. Manglapus further taught comprising spooling the print job to the printer (col. 1, lines 16-19, 25-31; col. 3, lines 57-62; col. 4, lines 30-31).

12. As per claim 9, Manglapus taught the invention as claimed in claim 1 above. Manglapus further taught wherein the second message is generated directly by the peripheral (col. 9, lines 47-53; col. 5, lines 5-8).

13. As per claim 11, Manglapus taught the invention as claimed in claim 1 above. Manglapus further taught comprising forwarding the first message to the peripheral, wherein the peripheral is connected to the peripheral server (fig. 2; col. 4, lines 64-col. 5, lines 9).

Claim Rejections – 35 USC 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manglapus.

16. As per claims 10 and 17, Manglapus taught the invention as claimed in claims 1 and 16 above. Manglapus did not specifically detailing the message is generated by a separate interface

device between the peripheral server and the peripheral. However, Manglapus taught wherein the second message is generated by peripheral with a built-in network interface (fig. 3; col. 5, lines 33-37; col. 10, lines 59-62). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include different configuration of interface device because by doing so would increase the flexibility of Manglapus's system by allowing the peripheral to connect to the network with different configuration.

17. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manglapus in view of Gunning et al, U.S. Patent 6,094,548 (hereinafter Gunning).

18. As per claim 5, Manglapus taught the invention as claimed in claim 3 above. Manglapus did not teach a PML object. Gunning taught wherein the print job contains a PML object (col. 3, lines 55-65; col. 4, lines 6-11).

19. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Manglapus and Gunning because Gunning's method of PML object would increase the efficiency of Manglapus's system by allowing embedded command to be transmitted with the print job in a single message.

20. As per claim 6, Manglapus and Gunning taught the invention substantially as claimed in claim 5 above. Manglapus further taught wherein the generating step comprises:

parsing the print job (col. 4, lines 2-5; col. 8, lines 11-26; col. 7, lines 1-23);

setting the PML object to contain the address of the client (col. 4, lines 5-7; col. 8, lines 11-26; col. 7, lines 1-23);

sending a trap request to an interface device (col. 1, lines 14-16; col. 4, lines 7-13; col. 8, lines 11-26; col. 7, lines 1-23);

receiving the trap request at the interface device (col. 8, lines 11-26; col. 7, lines 1-23);
and

parsing the PML object to find the address of the client (col. 4, lines 5-8; col. 8, lines 11-26; col. 7, lines 1-23).

21. As per claim 7, Manglapus and Gunning taught the invention substantially as claimed in claim 5 above. Manglapus and Gunning did not specifically detailing the type of PML. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include UI_SELECT_OPTION or other object as the PML object as the design choice of the invention because by doing so would increase the field of use in their invention.

22. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Manglapus in view of Wiley et al, U.S. Patent 5,687,320 (hereinafter Wiley).

23. As per claim 8, Manglapus taught the invention as claimed in claim 1 above. Manglapus did not specifically teach the message is a UDP datagram. Wiley taught wherein the second message is a UDP datagram (col. 6, lines 30-35; col. 9, lines 36-37).

24. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Manglapus and Wiley because Wiley's method of using UDP message would increase the efficiency of Manglapus's system by avoiding the time delay in waiting for the acknowledgement of the received message.

25. Claim 12-13 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manglapus in view of Bacher et al, U.S. Patent 6,728,012 (hereinafter Bacher).

26. As per claims 12-13 and 19-20, Manglapus taught the invention as claimed in claims 1 and 16 above. Manglapus did not teach wherein the peripheral is a multi-function peripheral. Bacher taught wherein the peripheral is a multi-function peripheral (abstract; col. 2, lines 45-54).

27. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Manglapus and Bacher because Bacher's multi-function peripheral would increase the field of use in Manglapus's system.

CONCLUSION

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schwarz, Jr., U.S. Patent 6,476,927, disclosed a system that request for the network address of a printer.


29. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Lee whose telephone number is (703)305-7721. The examiner can normally be reached on 8 AM TO 5:30 PM Monday to Thursday and every other Friday.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703)305-8498. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

32. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)350-6121.

P.L.


JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100